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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,964	11/03/2003	Patricia M. Reo	REO001P	5086

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/699,964

Applicant(s)

REO, PATRICIA M.

Examiner

Alicia Chevalier

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005 and 21 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 8, 9 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8, 9 and 15-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. 10/13/05
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

RESPONSE TO AMENDMENT

Due to an error in mailing, see interview summary, the following is the correct office and the time to respond has been ~~revised~~.

1. Claims 1-4, 8, 9 and 15-18 are pending in the application, claims 5-7 and 10-14 have been cancelled.
2. Amendments to the specification and the claims, filed on the response one April 25, 2005 and July 21, 2005, have been entered in the above-identified application.

REJECTIONS

3. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Specification

4. The disclosure is objected to because of the following informalities: Applicant has numbered only some of their paragraphs in the specification. If Applicant intends on numbering the paragraphs in the specification they must number them from the beginning, e.g. not with the first paragraph in the detailed description.

Appropriate correction is required.

5. The amendment filed April 25, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall

introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: on page 4, on line 3 of the specification "An adhesive that is hypo-allergenic and serves the requirements of the invention is designated as No. 597 by MACtac Division of Bernis Corporations." There is no support in the original disclosure to identify a specific "hypo-allergenic" adhesive.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102

6. Claims 1-4, 15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Yonkers (U.S. Patent No. 3,985,383).

Regarding Applicant's claim 1, Yonkers discloses a paper handling aid (*indexing device, title and col. 1, lines 6-12*) comprising a substantially planar membrane formed of a flexible, frictional material (*col. 2, lines 59-62 and col. 3, lines 14-29*) and sized to fit on the pad portion of a finger (*figure 1*), an adhesive coating on a first surface of the membrane (*col. 2, line 68 through col. 3, line 1*) and where in use the adhesive is in contact with the pad portion of the finger (*col. 2, line 68 through col. 3, line 2 and figure 1*).

Yonkers' pressure sensitive adhesive (*col. 2, line 68 through col. 3, line 1*) is deemed to be a hypo-allergenic adhesive, see comment below.

The term "hypo-allergenic" was coined for marketing products and is not a medical or FDA approved term or standard. Furthermore, Applicant's specification does not disclose what they considered to be "hypo-allergenic" adhesives, i.e. composition or what specific additive that

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makes it “hypo-allergenic”. Therefore, the term “hypo-allergenic” adhesive is taken to mean any type of adhesive.

Regarding Applicant’s claim 2, Yonkers discloses that the paper handling aid further comprises a plurality of protuberances formed on a second surface of the membrane (*figure 4 and col. 3, lines 59-62*).

The limitation “by molding” is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113. Furthermore, there does not appear to be a difference between the prior art structure and the structure resulting from the claimed method because Yonkers discloses protuberances on the second surface of the membrane.

Regarding Applicant’s claim 3, Yonkers discloses that membrane material is elastomeric (*col. 3, lines 21-22*).

Regarding Applicant’s claim 4, Yonkers implicitly implies that the adhesive adheres substantially permanently to the first surface of the membrane and adheres releasably to the pad portion of the figure, since the reference does not disclose that the friction material and adhesive separate and the reference does not disclose that the adhesive permanently attaches to a persons finger.

Regarding Applicant’s claim 15, Yonkers discloses that the protuberances are substantially equal in height above the second surface of the membrane (*figure 4*).

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Regarding Applicant's claim 17, Yonkers discloses a paper handling aid (*indexing device, title and col. 1, lines 6-12*) comprising a substantially planar membrane formed of a flexible, frictional material (*col. 2, lines 59-62 and col. 3, lines 14-29*) and sized to fit on the pad portion of a finger (*figure 1*), an adhesive coating on a first surface of the membrane (*col. 2, line 68 through col. 3, line 1*) and where in use the adhesive is in contact with the pad portion of the finger (*col. 2, line 68 through col. 3, line 2 and figure 1*). The protuberances are substantially equal in height above the second surface of the membrane (*figure 4*)

Yonkers' pressure sensitive adhesive (*col. 2, line 68 through col. 3, line 1*) is deemed to be a hypo-allergenic adhesive, see comment below.

The term "hypo-allergenic" was coined for marketing products and is not a medical or FDA approved term or standard. Furthermore, Applicant's specification does not disclose what they considered to be "hypo-allergenic" adhesives, i.e. composition or what specific additive that makes it "hypo-allergenic". Therefore, the term "hypo-allergenic" adhesive is taken to mean any type of adhesive.

Claim Rejections - 35 USC § 103

7. Claims 8, 9, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yonkers.

Yonkers is relied upon as described above.

Yonkers discloses that the traction material, i.e. membrane, has a very high coefficient of friction in order to facilitate handling and separating paper (*abstract, col. 1, lines 6-12 and col. 3, lines 15-18*)

Yonkers fails to disclose that the coefficient of friction is in the range of 0.50-0.90, more specifically 0.80.

Therefore, the exact coefficient of friction of the membrane is deemed to be a result effective variable with regard to the force needed to handle paper. It would require routine experimentation to determine the optimum value of a result effective variable, such as the coefficient of friction, in the absence of a showing of criticality in the claimed coefficient of friction. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Yonkers also fails to disclose that the protuberances protrude substantially 0.6 mm in height about the second surface of the membrane.

The exact height of the protuberance is deemed to be a result effective variable with regard to the coefficient of friction. It would require routine experimentation to determine the optimum value of a result effective variable, such as the height of the protuberance, in the absence of a showing of criticality in the claimed coefficient of friction. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

ANSWERS TO APPLICANT'S ARGUMENTS

8. Applicant's arguments in the response filed April 25, 2005 regarding the objections to the claims of record have been considered but are moot since the rejections have been withdrawn due to Applicant's amendments.

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9. Applicant's arguments in the response filed April 25, 2005 regarding the new limitation "a plurality of protuberances from *by molding* on a second of the membrane" of record have been considered but are moot due to the new grounds of rejection.

10. Applicant's arguments in the response filed April 25, 2005 regarding the 35 U.S.C. 102 and 103 rejections over Yonkers of record have been carefully considered but are deemed unpersuasive.

Applicant argues that Yonkers does not disclose a "hypo-allergenic" adhesive. Specifically, stating that the Examiner's comment that "hypo-allergenic" is not an FDA approved or medically approved term. Applicant further submits a definition from Webster's Collegiate Dictionary showing that the definition of hypoallergenic means having a decreased tendency to provoke an allergic reaction.

The definition that Applicant has provided for hypoallergenic is vague and indefinite. The definition does not eliminate ordinary adhesive from being able to decrease the tendency to provoke an allergic reaction. Furthermore, since there is no standard for what is considered to be a decrease in tendency to provoke an allergic reaction, anything can be considered hypoallergenic.

Applicant's argument regarding the addition is to the specification is moot due to the new matter objection to specification made above.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script, appearing to read "Alicia Chevalier".

Alicia Chevalier
Primary Examiner
10/13/05